

REMARKS

Applicant has amended claim 1 to improve the English by changing "air condition system" to air conditioning system." This is not new matter since the original specification at page 4, line 9 refers to this invention as an "air conditioning system." Applicant has added the indefinite article "a" before the phrase "multiple of crystals" which applicant has done at page 3, line 10 so this article is not new matter. It is necessary to indicate clearly the introduction of an element.

Applicant amends claim 3 to have a proper transition, "wherein," rather than the cumbersome phrase "within," which is not good English. This is not new matter since the words have really the same meaning. Applicant amends claim 3 so the past tense "improved" is changed to the present tense "improve," again for the purpose of improving the grammar of the claim. This is not new matter since the meaning of the verb has not been changed, only its tense.

35 U.S.C. section 112

Applicant has amended claim 1, the independent claim, so lack of clarity noted by the Examiner regarding "said conductor" is now clarified to read "said cold conductor and said hot conductor." This is not new matter since the original specification at page 2, lines 5-10 provided that "Both said contact surfaces of the baseboard then are respectively connected to a hot conductor and a cold conductor. Each conductor has a closed interior containing liquid and is provided with a water inlet and a water outlet to respectively connected (sic) to a pipeline comprised of a cooling coil and a heat dissipation coil from the air conditioner."

Applicant has amended claim 2 to omit the phrase "and other elements" to remove the uncertainty noted by the Examiner. Applicant replaces "include" with "comprise" so the meaning of the claim, that Sb and Bi are not necessarily the only elements, remains the same but the uncertainty has been removed. This is not new matter since nothing substantive has been added.

35 U.S.C. Section 102

Every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference (Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989)). Where all the elements or their equivalents cannot be found in one unit of prior art, there is no anticipation (Firestone v. Aluminum Co. of America, 285 F.2d 928, 127 U.S.P.Q. 407 (1960)). Phillips, et al. (US 3,236,056) does not contain the "multiple of crystals" element claimed in claim 1 herein. Therefore, This reference cannot anticipate the instant invention. The Examiner is respectfully requested to reconsider the rejection of this claim under 35 U.S.C. §102 and withdraw the same. Applicant also points out that feature 18 of Phillips is not a hot chamber as Examiner claims, but is instead a "polyurethane foam material for insulating the heat exchanger" (see column 1, lines 64 and 65). "When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.." (37 CFR 1.104 (c)(2)). Applicant respectfully requests the Examiner to explain what feature Examiner believes to be a hot chamber.

35 U.S.C. Section 103

The burden of proof is on the PTO to establish a prima facie case of obviousness (In Re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968), *rehearing denied*, 390 U.S. 1000 (1968)). The requisite view of the whole invention mandates consideration of not only its structure but also its properties and the problem solved (In Re Wright, 848 F.2d 1216, 6 U.S.P.Q.2d 1959, 1962 (Fed. Cir. 1988)). Section 103 does not require that the "person of ordinary skill" be presumed to have full knowledge of prior art outside the field of his endeavor, i.e. of nonanalogous prior art (In Re Antle, 444 F.2d 1168, 170 U.S.P.Q. 285 (C.C.P.A. 1971)). With regard to prior art outside the field of his endeavor, he is only presumed to have knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved (In Re Wood, 599 F.2d 1032, 202 U.S.P.Q. 171 (C.C.P.A. 1979)). The focus of inquiry is on the problem solver and not the user of the solution; i.e., it is the subject matter of the invention and not the field or industry which might thereafter have a use for the invention which must be looked to (Systematic Tool & Mach. Co. v. Walter Kiddle &

Co., 555 F.2d 342, 349 (3d Cir. 1977), *cert denied*, 434 U.S. 857, 195 U.S.P.Q. 466 (1977), and May v. American Southwest Waterbed Distribs., Inc., 715 F.2d 876, 219 U.S.P.Q. 862 (5th Cir. 1983), *rehearing denied*, 719 F.2d 404 (5th Cir. 1983), *cert. denied*, 465 U.S. 1103, 224 U.S.P.Q. 736 (1984)). When the alleged prior art does not specifically address the types of problems addressed by the technology of the invention, the prior art alleged is not applicable in combinations to render the invention obvious (Caster v. U.S., 9 U.S.P.Q.2d 1753 (Cls. Ct. 1988)). Where the prior art does not appreciate the existence of the problem solved by the invention, the Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention (In Re Nomiya, et al., 184 U.S.P.Q. 607, 612-613 (C.C.P.A. 1975)).

In the instant case the subject matter of the invention is an air temperature exchanger that can be placed into a pipeline between an existing cold coil and hot coil and used to further cool and heat the liquid in them respectively. Phillips et al. (US 3,236,056) does not disclose these cold and hot coils as they are disclosed in Applicant's claims. At column 1, line 69 through column 2, line 32 it can be seen that the car heater and engine radiator are not analogous to the "cold coil" and "hot coil" since "the pipe is in heat exchange relationship with the fins in the cold chamber." Applicant also points out that feature 18 of Phillips is not a hot chamber as Examiner claimed in the rejection of claim 1 under 35 U.S.C. §102, but is instead a "polyurethane foam material for insulating the heat exchanger" (see column 1, lines 64 and 65). "When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.." (37 CFR 1.104 (c)(2)). Applicant respectfully requests the Examiner to explain what feature Examiner believes to be a hot chamber. If there is no hot chamber in Phillips, the Examiner has not made a prima facie case for the obviousness of claims 2 and 3. Applicant respectfully requests the Examiner to reconsider the rejection of claims 2 and 3 under 35 U.S.C. §103 and withdraw the same.

Re: New Claims

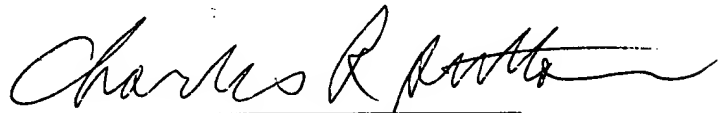
Claim 4 is not new matter because the hot conductor (30) can be seen in figure 3 of the original application to have an outside with fins. Claim 5 is not new matter since the original application discloses the eccentric fan that draws cool air away from the cold coil at page 4, lines 17-25.

Claim 6 is not new matter because the original application discloses a blade fan that draws hot air

away from the hot coil at page 5, lines 6-11. Claim 7 is not new matter since it is merely a combination of claims 4 and 6, both of which have already been demonstrated not to be new matter. Claim 8 is not new matter because it discloses the eccentric fan to draw cool air away from the cold coil which the original application disclosed at page 4, lines 17-25. Claim 9 is not new matter because it combines the non-new matter claim 8 with the blade fan to draw hot air away from the hot coil which was disclosed in the original application at page 5, lines 6-11. Claim 10 is not new matter because it only adds the blade fan to draw hot air away from the hot coil which was disclosed in the original application at page 5, lines 6-11. Claim 11 is not new matter because it discloses the pipeline with external fins seen at Figure 8 of the original application. Claim 12 is not new matter because the original application disclosed at page 5, lines 23-25 and also figure 7 that multiple units of the temperature exchanger could be applied in an air conditioning system to facilitate cooling the air.

WHEREFORE, Applicant respectfully requests the Examiner to enter the amendments, reconsider and withdraw the rejections of and objections to claims 1-3.

Respectfully submitted,



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